

REMARKS

Claims 1-53 were previously pending. Claims 19-53 have been withdrawn from consideration. No claims have been canceled or added. Reconsideration of presently pending claims 1-18 is respectfully requested in light of the above amendments and the following remarks.

Election/Restriction Requirements

Applicants appreciate Examiner's acknowledgement of the election of Group 1 and Species 2. Further, applicants acknowledge the withdrawal of claims 19-53.

Objection to Specification

The specification was objected to as failing to provide proper antecedent basis for the claimed subject matter. In particular, the Office Action noted that prosthetic insertion device, receiving means, locking means, and vertebral-engaging members must be supported in the specification with appropriate reference numerals. Applicants find no support in 37 C.F.R. §1.75(d)(1) or MPEP §608.01(o) for the assertion that these terms must be labeled with reference numerals. These sections require that the "meaning of every term used in any of the claims should be apparent from the descriptive portion of the specification" and "the terms and phrases used in the claims must find clear support or antecedent basis in the description." As illustrated below, the meanings of the terms prosthetic insertion device, receiving means, locking means, and vertebral-engaging members are clear and have support from description and, therefore, satisfy the requirements of 37 C.F.R. §1.75(d)(1) and MPEP §608.01(o). Thus, Applicants respectfully request the Examiner to withdraw the objection to the specification for failing to provide a proper antecedent basis for the claimed subject matter.

With respect to "prosthetic insertion device," paragraph [0043] states that, "The end members 22, 22' of the anchoring device 20 are adapted to receive a variety of prosthetic insertion devices . . . For example, . . . , the anchoring device 20 may be used in conjunction with a motion-preserving device 30" Also, paragraph [0059] notes that "a variety of prosthetic insertion devices other than the motion-preserving device 30 can be used . . . For example, . . . a fusion member." Thus, "prosthetic insertion device" should be understood broadly to mean any type of prosthetic device adapted for insertion between two components or members.

With respect to “receiving means,” this term should be given its ordinary meaning: a means for receiving. The specification provides several examples, but not an exhaustive list, of receiving means. For example, paragraph [0049] states in part in reference to Fig. 2a, “The slots 66, 68 are open at an anterior portion of the end member 22 [] in order to receive corresponding portions of the socket component 34 of the motion preserving device 30.” Thus, slots 66, 68 are one example of a receiving means as they are adapted to receive portions of the socket component 34. Receiving means as used in the claims is understood to have a broad meaning according to its ordinary meaning, encompassing any means for receiving something.

Similarly, with respect to “locking means,” this term should be given its ordinary meaning: a means for locking. Again, the specification provides several examples, but not an exhaustive list, of locking means. For example, paragraph [0051] states in part in reference to Fig. 2b, “It is understood that other locking mechanisms other than the depicted cam devices 80, 82 are contemplated . . . such as pressure fits or slot and peg assemblies.” Thus, cam devices, pressure fits, and slot-and-peg assemblies are each examples of locking means. Locking means as used in the claims is understood to have a broad meaning according to its ordinary meaning, encompassing any means for locking or securing something in position.

Finally, with respect to “vertebral-engaging members,” this term should also be given its ordinary meaning: a member for engaging a vertebra. The specification provides several examples, but not an exhaustive list, of vertebral-engaging members. For example, paragraph [0046] states in part, “The fins 40, 42 are provided for engaging an adjacent vertebral body . . . It is understood [] that the fins 40, 42 may be configured in any shape that facilitates the functional demands of the fins . . .” Thus, vertebral-engaging members as used in the claims is understood to have a broad meaning according to its ordinary meaning, encompassing any member or component adapted to engage a vertebra.

§112 Rejections

Claims 1-18 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention. The particular reasons are set forth and addressed below.

With respect to claims 1 and 14-16, the Office Action questioned the meaning of “prosthetic insertion device.” The term “prosthetic insertion device” as used in claims 1 and 14-

16 should be understood in line with its use in the specification and its ordinary meaning. As previously noted, paragraph [0043] states that, “The end members 22, 22’ of the anchoring device 20 are adapted to receive a variety of prosthetic insertion devices For example, . . . , the anchoring device 20 may be used in conjunction with a motion-preserving device 30” Further, at paragraph [0059] it is noted that, “a variety of prosthetic insertion devices other than the motion-preserving device 30 can be used For example, . . . a fusion member.” Thus, Applicants submit that the meaning of “prosthetic insertion device” is clear. Therefore, Applicants respectfully request that the Examiner withdraw the §112 rejection of claims 1 and 14-16.

With respect to claim 12, the Office Action questioned the meaning of a “wall extending transversely.” The term “wall extending transversely” as used in claim 12 should be understood in line with its ordinary meaning. The Merriam-Webster Online Dictionary defines transverse as “acting, lying, or being across : set crosswise.” In the context of claim 12, “a wall extending transversely relative to the at least one flange” means a wall extending crosswise or perpendicular to the at least one flange. Thus, Applicants submit that the meaning of “a wall extending transversely” is clear. Therefore, Applicants respectfully request that the Examiner withdraw the §112 rejection of claim 12.

With respect to claim 14, the Office Action noted that “the first end member” lacks an antecedent basis. However, claim 14 begins, “An anchoring device for receiving a prosthetic insertion device, comprising: a first end member, comprising. . . .” It is only after this recital of “a first end member” that claim 14 refers to “the first end member.” Thus, Applicants respectfully submit that “the first end member” in claim 14 has a proper antecedent basis. Therefore, Applicants respectfully request that the Examiner withdraw the §112 rejection of claim 14.

Finally, with respect to claim 16, the Office Action questioned the meaning and support for the “receiving means.” Claim 16 states in part, “comprising first and second end members each comprising at least one receiving means . . . and a prosthetic insertion device comprising a means for engaging the at least one receiving means of the first and second end members” Again, paragraph [0043] notes that, “[t]he end members 22, 22’ of the anchoring device 20 are adapted to receive a variety of prosthetic insertion devices” Thus, “receiving means” includes any means capable of receiving a variety of prosthetic insertion devices, including the

prosthetic insertion device of claim 16 comprising a means for engaging the at least one receiving means. Thus, Applicants respectfully submit that “receiving means” is supported and understood in light of the ordinary meaning and the specification. Therefore, Applicants respectfully request that the Examiner withdraw the §112 rejection of claim 16.

§102 Rejections

U.S. Patent No. 5,658,335 to Allen

Claims 1-5, 9-12, and 14-18 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,658,335 to Allen (“Allen”).

The PTO provides in MPEP § 2131 that

“[t]o anticipate a claim, the reference must teach every element of the claim...”

Therefore, to sustain the rejection of these claims Allen must teach all of the claimed elements. However, Allen fails to disclose all of the claimed elements of independent claims 1, 14, 15, and 16 and, therefore, dependent claims 2-5, 9-12, and 17-18.

With respect to amended claim 1, Allen at least fails to teach “a first sidewall, a second sidewall, and a back wall extending from the second surface to define a socket adapted to receive a portion of the prosthetic insertion device,” as recited by claim 1. Allen also at least fails to teach “at least one retention member moveable between a first position outside of the socket for allowing the portion of the prosthetic insertion device to slide within the socket and a second position at least partially within the socket to inhibit sliding of the portion of the prosthetic insertion device within the socket,” as recited by claim 1. Thus, Allen fails to teach all of the claimed elements of claim 1.

With respect to amended claim 14, Allen at least fails to teach “a first end member, comprising: a first surface in an opposed relation to a substantially parallel second surface.” Similarly, Allen also at least fails to teach “the second end member comprising: a first surface in an opposed relation to a substantially parallel second surface.” As shown best in Figs. 12 and 13 of Allen, the surfaces of the four crown members 90 are not substantially parallel. Thus, Allen fails to teach all of the claimed elements of claim 14.

With respect to amended claim 15, Allen at least fails to teach “a second surface in an opposed relation and substantially parallel to the first surface,” as discussed above with respect

to claim 14. Thus, Allen fails to teach all of the claimed elements of claim 15 as well.

With respect to amended claim 16, Allen at least fails to teach “first and second end members each comprising . . . at least one locking means positioned adjacent to the receiving means.” Allen fails to disclose end members having at least one locking means. For similar reasons, Allen at least fails to teach “the prosthetic insertion device being adapted to be releasably secured to the first and second end members by the at least one locking means of the first and second end members.” Thus, Allen fails to teach all of the claimed elements of claim 16.

Allen fails to disclose all of the claimed elements of independent claims 1, 14, 15, and 16 and, therefore, all of the claimed elements of dependent claims 2-5, 9-12, and 17-18. Therefore, Applicants respectfully request that the Examiner withdraw the §102 rejections of claims 1-5, 9-12, and 14-18.

U.S. Patent No. 6,572,653 to Simonson

Claims 1, 4-13, and 15-17 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,572,653 to Simonson (“Simonson”).

The PTO provides in MPEP § 2131 that

“[t]o anticipate a claim, the reference must teach every element of the claim....”

Therefore, to sustain the rejection of these claims Simonson must teach all of the claimed elements. However, Simonson fails to disclose all of the claimed elements of independent claims 1, 15, and 16 and, therefore, dependent claims 4-13 and 17-18.

With respect to amended claim 1, Simonson at least fails to teach “first and second end members cooperating to slidably receive a prosthetic insertion device,” as recited by claim 1. Simonson does not teach slidably receiving a prosthetic insertion device. Also, Simonson at least fails to teach “at least one retention member moveable between a first position outside of the socket for allowing the portion of the prosthetic insertion device to slide within the socket and a second position at least partially within the socket to inhibit sliding of the portion of the prosthetic insertion device within the socket.” Thus, Simonson fails to teach all of the claimed elements of claim 1.

With respect to amended claim 15, Simonson at least fails to teach “at least one flange extending from the second surface defining a channel adapted to slidably receive the portion of the prosthetic insertion device.” As mentioned above, Simonson does not teach slidably receiving a prosthetic insertion device and, therefore, does not teach defining a channel adapted to slidably receive a portion of a prosthetic insertion device. Further, Simonson at least fails to teach “a means for releasably securing the portion of the prosthetic insertion device disposed adjacent the channel.” Simonson does not teach a means for releasably securing a prosthetic insertion device, let alone, a means disposed adjacent a channel adapted to slidably receive a portion of the prosthetic insertion device. Thus, Simonson fails to teach all of the claimed elements of the claim 15.

With respect to amended claim 16, Simonson at least fails to teach “a prosthetic insertion device comprising a means for slidably engaging the at least one receiving means of the first and second end members.” Similar to Simonson’s failure to teach slidably receiving a prosthetic insertion device, Simonson fails to a prosthetic insertion device for slidably engaging a receiving means. Thus, Simonson fails to teach all of the claimed elements of claim 16.

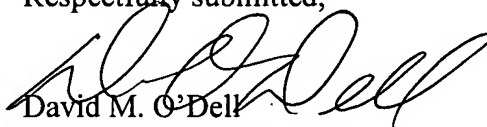
Simonson fails to disclose all of the claimed elements of independent claims 1, 15, and 16 and, therefore, all of the claimed elements of dependent claims 4-13 and 17. Therefore, Applicants respectfully request that the Examiner withdraw the §102 rejections of claims 1, 4-13 and 15-17.

CONCLUSION

It is clear from the foregoing that independent claims 1, 14, 15, and 16 are in condition for allowance. Dependent claims 2-13 and 17-18 depend from and further limit independent claims 1 and 16 and, therefore, are allowable as well.

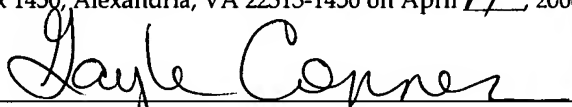
It is believed that all matters set forth in the Office Action have been addressed, and that claims 1-18 are in condition for allowance. Favorable consideration and an early indication of the allowance of the claims are respectfully requested. Should the Examiner deem that an interview with Applicant's undersigned attorney would expedite consideration, the Examiner is invited to call the undersigned attorney at the telephone number indicated below.

Respectfully submitted,



David M. O'Dell
Registration No. 42,044

Dated: April 14, 2006
HAYNES AND BOONE, LLP
901 Main Street, Suite 3100
Dallas, Texas 75202-3789
Telephone: 972/739-8635
Facsimile: 214/200-0853
R-132368.1

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on April <u>14</u> , 2006.

Gayle Conner